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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|----------------------|------------------|
| 10/051,115                    | 01/22/2002  | Kazuyuki Matsumura   | 0171-0813P-SP        | 7493             |
| 2292                          | 7590        | 05/10/2004           | EXAMINER             |                  |
| BIRCH STEWART KOLASCH & BIRCH |             |                      | SHEWAREGED, BETELHEM |                  |
| PO BOX 747                    |             |                      | ART UNIT             | PAPER NUMBER     |
| FALLS CHURCH, VA 22040-0747   |             |                      | 1774                 |                  |

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/051,115

### Applicant(s)

MATSUMURA ET AL.

### Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's response and Request for Continued Examination (RCE) filed on 04/23/2004 has been fully considered. Claim 2 is canceled, claim 11 is added, and thus claims 1 and 3-11 are pending. (NOTE: Claims 9-11 are withdrawn from consideration as non-elected invention).

### ***Election/Restrictions***

2. Newly submitted claim 11 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 11 is directed to a method of the claimed ink jet printing paper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 1 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

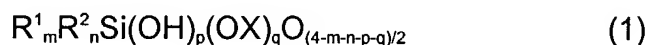
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaya (EP 0 841 355 A2).

Yamaya discloses an article comprising a paper substrate (page 15, line 39) coated with an emulsion composition comprising component (1) 100 parts by weight of a water-insoluble silanol group-bearing silicone resin of formula (1):



Wherein  $R^1$  is unsubstituted monovalent hydrocarbon group preferably those having 1-10 carbon atoms (page 6, line 1),  $R^2$  is a substituted monovalent hydrocarbon group preferably those having 1-10 carbon atoms (page 6, line 9), X is a monovalent hydrocarbon group having 1-6 carbon atoms (page 6, line 27), letters m, n, p and q are numbers satisfying  $0.5 \leq m \leq 1.8$ ,  $0 \leq n \leq 1.0$ ,  $0 < p \leq 1.5$ ,  $0 \leq q \leq 0.5$ ,  $0.5 \leq m+n \leq 1.8$ , and  $0 < p+q \leq 1.5$ , and component (2) 10 to 1,000 parts by weight of a radical polymerizable vinyl monomer (page 3, lines 39-53). Component (1) is equivalent to the claimed component (a-1) and component (2) is equivalent to the claimed component (b).

### ***Response to Arguments***

5. Applicant's argument is based on that Yamaya fails to disclose applying the emulsion to paper while the paper is being made, instead Yamaya discloses applying the emulsion to paper that has already been made, thus the product of Yamaya is

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physically different from the product of the claimed invention. This argument is not persuasive because the argument is directed to a process limitation while the claimed invention is directed to an article. Since the specification fails to show that the product prepared by applying the emulsion to paper while the paper is being made is physically different from the product prepared by applying the emulsion to paper that has already been made, Applicant is strongly advised to provide factual evidence showing that the two products are physically different because they are prepared by different methods. Since Applicant failed to provide the requested factual evidence, the rejection over Yamaya is kept, and claims 1 and 3-8 stand rejected.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Shewareged'.

Betelhem Shewareged  
May 4, 2004.